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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/242,828 02/24/99 SHIMIZU

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IM62/0112

EXAMINER

NAKARANI, D

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

8
01/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/242,828

Applicant(s)
Shimizu et al

Examiner
D. S. Nakarani

Group Art Unit
1773



☒ Responsive to communication(s) filed on Oct 2, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 8-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 8-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 8-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8, lines 5-6, the phrase "acetylene glycol in which each carbon atom immediately adjacent to a triple bonded carbon atom is substituted with a hydroxyl group and a methyl group (see claim 1, lines 8-10, Page 4, lines 7-9, page 5, lines 22-24, and page 6, lines 8-9). There is no support for the phrase "acetylene glycol in which each carbon atom immediately adjacent to a triple bonded carbon atom is substituted with a hydroxyl group and a methyl group i.e.,

$$\text{HO}-\overset{\text{H}}{\underset{\text{CH}_3}{\text{C}}}-\text{C}\equiv\text{C}-\overset{\text{H}}{\underset{\text{CH}_3}{\text{C}}}-\text{OH}$$
 which is not supported by the originally filed specifications. The structure of acetylene glycol is either (1) $\text{HOC}\equiv\text{COH}$ or (2) $\text{HOCH}=\text{CHOH}$.

The structure $\text{HOCH}=\text{CHOH}$ is based on presumption that the acetylene glycol is probably produced using acetylene oxide. However, replacing two adjacent triple-bonded carbon atoms with a hydroxyl and a methyl group renders confusion. It is not clear how one can replace both triple bonded carbon with a hydroxyl group and a methyl group? No clarification on this matter provided.

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Further applicants are requested to note that new claim 11 depends from claim 1 which has been canceled but for purpose of this rejection, the claim 11 has been treated as depending from claim 8 and not from claim 1.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim 11 depends from Claim 1 which has been canceled making claim 11 incomplete.

4. Applicant's arguments filed October 2, 2000 have been fully considered but they are not persuasive. In reference to rejection of claims under 35 U.S.C. 112 first paragraph set forth in paragraph 3 of the Office action mailed July 6, 2000, applicants mainly argue that the specification, as filed, clearly explains adding acetylene glycol to water polyurethane resin, wherein the two carbon atoms adjacent triple bonded carbons of the acetylene glycol are replaced with a hydroxyl group and a methyl group. The specifications indicates as examples that surfynol 104 and 440 are useful as the acetylene glycol and the addition product thereof at page 3, third paragraph and at page 11, Embodiments 1 and 2.

These arguments are unpersuasive because at page 3, third paragraph does not show description acetylene glycol or surfynol 104 and 440. At page 5, third paragraph show "acetylene glycol, in which two adjacent triple bonded carbon atoms are replaced with a hydroxyl group and

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a methyl group, and/or a non-ionic surface active agent, which is an addition product of the ethylene oxide, to the water polyurethane resin. For the surface active agent Surfynol 104 and 140, produced .---" there is nothing in this paragraph stating that Surfynol 104 and 140 or 440 is an acetylene glycol in which each carbon atom immediately adjacent to a triple-bonded carbon atoms is substituted (replaced) with a hydroxyl group and a methyl group. There is no evidence provided to show that surfynol 104 and 440 is a product as stated. In absence of such evidence claim 8, lines 5-6, the phrase as stated in paragraph 2 above is a new matter.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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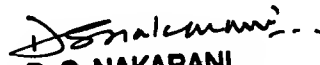
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (703) 308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00a.m. to 5:30p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nakarani/ph

January 5, 2001


D. S. NAKARANI
PRIMARY EXAMINER